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10/750,810	12/31/2003	Werner Holzl	HM/5-21810/A/PCT/DIV	1623
324	7590	04/19/2006	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			BADIO, BARBARA P	
		ART UNIT		PAPER NUMBER
		1617		
DATE MAILED: 04/19/2006				

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**MAILED**  
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**GROUP 1600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/750,810  
Filing Date: December 31, 2003  
Appellant(s): HOLZL ET AL.

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Kevin T. Mansfield  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 16, 2006 appealing from the Office action mailed September 21, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

An Appeal Brief was filed in parent case 09/762,008. The examiner of record reopened prosecution and ultimately allowed the application (see US Patent No. 6,689,372).

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

1,079,348	MUEHLBAUER et al.	8-1967
4,115,588	KAMINSKI et al.	9-1978
4,772,689	LANG et al.	9-1988
4,847,088	BLANK	7-1989
5,833,997	MAHIEU et al.	11-1998
6,552,080	KIM et al.	4-2003

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muehlbauer et al. (GB 1079348) and Kaminski et al. (US 4,115,588) or Lang et al. (US 4,772,689) or Blank (US 4,847,088) in combination.

Muehlbauer et al. teaches oxathiazole derivatives, such as 5-methyl-1,3,4-oxathiazol-2-one and 5-(chloromethyl)-1,3,4-oxathiazol-2-one, and their fungicidal

property (see the entire article, especially page 3, lines 7-14; Examples 1-3 and 9; claims 13-16).

Each of Kaminski et al., Lang et al. and Blank teaches that it is known in the art to incorporate fungicidal agents into various compositions including cosmetic preparations such as mouthwashes, shampoos, soaps etc. (see '588, col. 17, lines 25-37; '689, col. 3, lines 40-44; '088, col. 1, line 11 – col. 2, line 37) to prevent contamination and deterioration of said products.

Based on the teachings of the prior art and the level of skill of the ordinary artisan in the cosmetic art, it would have been obvious to the skilled artisan at the time of the present invention to utilize the oxathiazole derivatives taught by Muehlbauer in the compositions taught by Kaminski, Lang and Blank with the reasonable expectation of preventing the contamination and deterioration of said compositions. The motivation would be based on (a) the teachings of Muehlbauer that said oxathiazole derivatives have fungicidal properties and (b) the knowledge in the cosmetic art that antimicrobial agents prevent contamination and deterioration of cosmetic products.

#### **(10) Response to Argument**

Applicant argues Muhlbauer et al. teaches a certain fungicidally active oxathiazol-2-one derivatives that can be used directly as agricultural fungicides and not a personal care composition as claimed in claim 18 or an oral composition as claimed in claim 19. According to applicant, the reference teaches an agricultural composition. Applicant also argues (a) that the acetone solution, as taught by Muhlbauer, could not

be used in a personal care or oral composition and reference is made to a 2005 material safety data sheet; (b) each of Muhlbauer et al., Kaminski et al., Lang et al. and Blank et al., teaches a different specific class of antimicrobial or fungicidally active substance and various uses of compositions containing said substances and (c) the inference that any antifungal agent, in particular the fungicidal compounds of Muhlbauer et al., could be safely used in personal care composition is hindsight speculation. Applicant's argument was considered but not persuasive for the following reasons.

First, (a) each of Kaminski et al., Lang et al. and Blank et al. was cited for their teaching of the use of "fungicidal agents" into various compositions including cosmetic preparations such as mouthwashes, shampoos and soaps and (b) each of Kim et al. and Mahieu et al., was cited for their teaching of acetone as a fungicidally acceptable carrier. The fact that they teach different classes of antimicrobial or fungicidally active substances and uses thereof is noted but not relevant. The relevant issues are the art teaches (a) the use of fungicidal agents in cosmetic preparations, including personal care and oral preparations and (b) the use of acetone and other carriers, such as water, as fungicidally acceptable carriers as evidenced by the above-cited references.

Applicant also argues "acetone" is not safe for use in personal care or oral preparations. It is noted that "personal care preparation" is inclusive of preparations such as nail polish preparations (see page 6, paragraph 4 of the present specification). The use of acetone in said preparations is well known in the art. In addition, the art teaches various "fungicidally active carrier", including water, which is orally tolerable.

Thus, the use of other fungicidal carriers as known in the art to formulate an oral composition containing the prior art fungicidal agent would be *prima facie* obvious. Lastly, applicant argues Mahlbauer et al. is limited to “agricultural” fungicides and does not teach the fungicidal oxathiazol-2-one derivatives could be safely applied to a human body. It should be noted that the claims are drawn to compositions containing the claimed compound(s) in a “cosmetically tolerable” or “orally tolerable” adjuvant. The art teaches fungicidally acceptable carriers that are orally and/or cosmetically tolerable and, thus, the formulation of the prior art oxathiazol-2-one derivatives utilizing various known carriers would have been obvious to the skilled artisan in the art at the time of the present invention based on the level of skill of the ordinary artisan in the art. In addition, (a) the claims are not limited to human use and (b) applicant’s intended use does not lend patentability to a known or obvious composition.

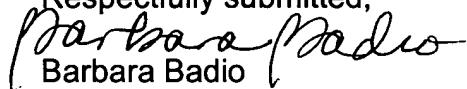
In summary, Muhlbauer et al. teach a fungicidal composition containing acetone and the art teaches various fungicidal acceptable carriers including water and acetone. Based on the teachings of the prior art and the level of skill of the ordinary artisan in the art, the utilization of the compounds taught by Muhlbauer with carriers such as acetone and water would have been obvious to the skilled artisan in the art at the time of the present invention because both carriers are known to be fungicidally acceptable carriers.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Barbara Radio

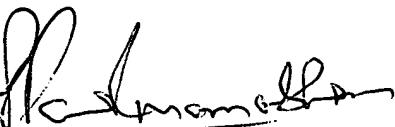
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